

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Bryan

Serial No.: 09/871349

Filing Date: May 31, 2001

Title: Game Board and Game Having a
Touring Band Theme

Docket No.: 4822-001

Examiner: Mr. Vishu K. Mendiratta

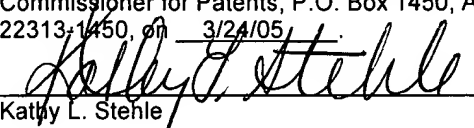
Group Art Unit: 3711

Confirmation No.: 9565

Mail Stop Appeal Briefs - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited
with the United States Postal Service as first class mail in an
envelope addressed to: Mail Stop Appeal Briefs - Patent,
Commissioner for Patents, P.O. Box 1450, Alexandria, VA
22313-1450, on 3/24/05.


Kathy L. Stehle

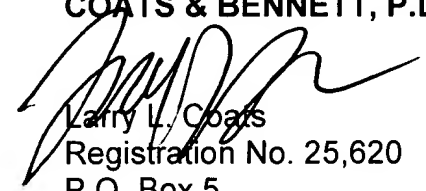
Sir:

It is hereby requested that a **One**-month extension of time be granted to respond
to the Office Action dated November 24, 2004. The requisite fee of **\$60.00** set forth in
§1.17(a)(1) of the Rules of Practice is submitted herewith. If fees are not sufficient,
please deduct from our Deposit Account No. 18-1167.

Respectfully submitted,

COATS & BENNETT, P.L.L.C.

By:


Larry L. Coats
Registration No. 25,620
P.O. Box 5
Raleigh, NC 27602
Telephone: (919) 854-1844

03/29/2005 MAHMED1 00000014 09871349

01 FC:2251

60.00 DP



1400 Crescent Green
Suite 300
Cary, North Carolina 27511
tel: 919-854-1844
800-575-1278
fax: 919-854-2084
www.coatsandbennett.com

Patents, Trademarks,
Copyrights, Trade Secrets,
Licensing, and
Related Litigation

March 24, 2005

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Re: U.S. Patent Application No. 09/871,349
Filed: May 31, 2001
Inventor: Paul Bryan
Game Board and Game Having A Touring Band Theme
Our Reference No.: 4822-001

Larry L. Coats
David E. Bennett
John R. Owen
David D. Kalish
Anthony J. Biller
Michael D. Murphy
Edward H. Green III
Andrew R. Aranda
Rebecca E. Crandall

Stephen A. Herrera*
Jennifer K. Stewart*

*registered patent agent

Dear Sir or Madam:

Pursuant to Rule 1.191 Applicant submits an additional brief in triplicate to the Board of Patent Appeals and Interferences. This follows an earlier brief and a remand by the Board.

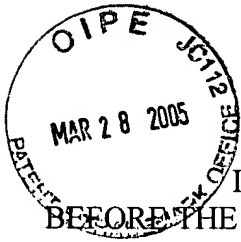
The present brief addresses issues raised in the office action dated November 24, 2004. In addition, a Rule 1.132 Declaration has been filed in this case and accompanies this brief. Good cause exists for filing the Declaration. After remand from the Board, the Examiner has raised new grounds of rejections and the Declaration addresses the new grounds. Applicant could not have submitted the evidence before since the grounds of rejection that the Declaration addresses had not been made.

If additional fees are required please charge them to Deposit Account No. 18-1167.

Sincerely,

Larry L. Coats

LLC/kls
Enclosures



IN THE UNITED STATES PATENT OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re U.S. Patent Application of:)
Bryan)
Serial No. 09/871,349) Vishu Mendiratta
Filed May 31, 2001) Examiner
For: **Game Board and Game Having a**) Group 3711
Touring Band Theme)
Attorney Docket No. 4822-001)

Raleigh, North Carolina
24 March 2005

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The present appeal brief is filed in triplicate pursuant to 37 C.F.R. § 1.192. The Patent Office is advised that this is the second appeal brief filed in this case. The Patent Office Board of Appeals and Interferences remanded the case to the Examiner after Applicant filed the first brief. Applicant opts to continue to pursue his appeal even though the last office action was non-final. Applicant is a small entity. If additional fees are required, the Commissioner is authorized to charge Deposit Account 18-1167.

APPEAL BRIEF

(1) REAL PARTY IN INTEREST

The real party in interest is Paul J. Bryan, whose address is 413 East Millbrook, Raleigh,

NC 27609.

(2) RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences to the best of Applicant's knowledge.

(3) STATUS OF CLAIMS

Claims 1-11 and 13-15 are pending in this application. The Examiner has rejected all pending claims. Accordingly, Applicant appeals the rejection of claims 1-11 and 13-15.

(4) STATUS OF AMENDMENTS

There are no amendments to the claims. A Rule 1.132 Declaration by the inventor, Mr. Paul Bryan, is being filed contemporaneously with this appeal brief. A copy of the Rule 1.132 Declaration is attached in the Evidentiary Appendix. Because the Examiner raised new grounds of rejections and the fact that the action is non-final, it is believed that it is appropriate and timely for Applicant to submit the Rule 1.132 Declaration.

(5) SUMMARY OF CLAIMED SUBJECT MATTER

All claims relate to a board game having a game board with a performing stage and a network of paths. The game includes a series of tokens and at least two decks of cards, one deck of cards being "consequence" cards and the other deck of cards being "band member" cards.

There are two independent claims that are pending and which are being appealed, claims 1 and 11. Claim 1 is directed to a game comprising a game board 100 (Spec., p. 3). The game board includes a central performing stage 112 and a starting area 114. Further, the game board

includes a network of paths 116, 118, 120 and 140 (Spec. p. 4 and Figure 1). The network of paths includes a series of segments with each segment being broken down into increments. (See Figure 1).

Claim 1 also calls for a series of tokens 130 (Spec. p. 6 and Figure 2). Further, claim 1 and the game includes at least one die 128. (Spec. pp. 5-6 and Figure 2). Additionally, the game claimed in claim 1 includes a supply of money 132. (Figure 2). Claim 1 calls for three separate decks of cards, a deck of consequence cards 124, a deck of band member cards 122, and a deck of band equipment cards 138. (Spec. p. 5 and Figure 2). The deck of band member cards is divided into a series of groups of cards. Each group of band member cards designating a band and members of the band. (Spec. p. 11).

Claim 11 is directed to a game comprising a game board 100. (Spec. p. 3 and Figure 1). Game board 100 includes a performing stage 114 and a network of paths 116, 118, 120 and 140 (Spec. p. 4) that lead to the performing stage 114. A series of tokens 130 form a part of the claimed game and game board and are advanced from the starting point 114 along the paths of the network paths. There are at least two decks of cards set forth in claim 11. There is a first deck of cards 124 which are “consequence” cards. There is a second deck of cards 122 which are “band member” cards. The band member cards 122 include a plurality of groups of cards with each group of cards representing a band and the members of the band. (Spec. p. 11 and Figure 2).

(6) GROUND OF REJECTION

Claims 1-5, 7-11, 13, 15 are rejected under 35 U.S.C. §103(a) as being unpatentable over Elrod (U.S. Patent No. 4,998,736) in view of *Ex. Parte Breslow*, 192 USPQ 431 or *In re Ngai*, 367 F.3d 1336 (Fed. Cir. 2004) or *In re Gulack*, 703 F.2d 1381 (Fed. Cir. 1983).

Claim 6 is rejected under 35 U.S.C. §103(a) as being unpatentable over Elrod in view of *Ex. Parte Breslow/In re Ngai/In re Gulack* as applied in claim 1 above in further view of Hunsberger (U.S. Patent No. 6,279,908).

Claim 14 is rejected under 35 U.S.C. §103(a) as being unpatentable over Elrod in view of *Ex. Parte Breslow/In re Ngai/In re Gulack*.

(7) GROUPING OF CLAIMS

The claims are grouped as follows:

Group I - Claims 1, 2, 3, 4, 5, 7, 8, 9, 10 and 15.

Group II - Claim 6

Group III - Claim 11

Group IV - Claim 13

Group V - Claim 14

Each group of claims will be argued separately for each rejection.

(8) ARGUMENT

A. Claims 1-5, 7-11, 13 and 15 Are Not Obvious In View of Elrod and Ex. Parte Breslow or In re Ngai or In re Gulack.

Claim 1

Independent claim 1 and claims 2, 3, 4, 5, 7 and 15 constitute one group of claims to be argued under this rejection. Specifically, claim 1 will be argued. Claim 1 is as follows:

1. A game board and game, comprising:
 - (a) a game board having a starting area, a network of irregular paths that lead from the starting area; and a central performing stage located generally centrally on the game board and connected to at least one segment of the network of paths;
 - (b) the network of paths including a series of segments wherein each segment is broken down into increments and wherein at least some of the increments include indicia formed thereon that dictate an action for landing on a particular increment;
 - (c) a series of tokens provided with the game board wherein a token may be assigned to one player and during the course of a game the token is advanced along one or more of the segments of the network of paths;
 - (d) at least one die that is used to determine the number of increments that a player's token can be advanced during the course of the game;
 - (e) a supply of money that during the course of the game is distributed to the players;
 - (f) a deck of "Consequence" cards that are keyed to certain increments on the network of paths, each "Consequence" card having indicia thereon that sets forth a consequence and wherein a player landing on an increment that calls for drawing a consequence card must comply with the directive set forth on the drawn consequence card;
 - (g) a deck of "Band Member" cards with the deck being divided into a series of groups with each group of "Band Member" cards designating members of a band;
 - (h) a series of "Band Equipment" cards with each card designating band equipment; and

- (i) wherein the object of the game is for each player to advance his or her token along the network of paths and reach the central stage with a predetermined number of one group of “Band Member” cards and a “Band Equipment” card.

1. The Examiner’s Inclusion of Legal Authority in the Articulation of the Basis of the Obviousness Rejection is Legal Error.

The Examiner in rejecting claim 1 has combined Elrod with any one of a series of reported cases. This is not only highly unusual, but is confusing. Conventionally a rejection under 35 U.S.C. §103(a) states the factual basis for the rejection and this is usually stated by setting forth the particular prior art that is relied upon to make out a prima facie case of obviousness. Here the Examiner has combined legal authority with Elrod as if the legal authority constituted prior art. In short, the articulation of the obviousness rejection is wrong as a matter of law. For this reason alone, the rejection of claim 1 and the claims grouped therewith should be reversed.

2. Claim 1 Includes a Third Deck of Band Equipment Cards Not Found in Elrod and Not Even Addressed By the Examiner.

As stated in Section 706.02(j) of the MPEP the Examiner when making an obviousness rejection must set forth the relevant teachings of the prior art, the differences between the claim and the prior art, the proposed modification of the applied references necessary to arrive at the claimed subject matter, and an explanation of why one of ordinary skill in the art at the time of the invention was made would have been motivated to make the proposed modification.

First, claim 1 calls for three separate decks of cards, a deck of consequence cards, a deck of band member cards, and a series of band equipment cards. The Examiner in the final office action at page 2 only addresses two of the decks of cards. That is, the Examiner maintains that in

Elrod the deck of cards referred to by the numeral 124 constitute the consequence cards and that the deck of cards denoted by the numeral 126 constitutes the second deck of cards or the band member cards. However, nowhere in the office action does the Examiner address the series of band equipment cards. Indeed, Elrod does not include a third set or deck of cards and certainly not band equipment cards.

Obviousness can never be established unless the modified primary reference shows each and every limitation of the claim. The Examiner did not modify Elrod to include a third deck of cards, nor did the Examiner modify Elrod to show a third deck of band equipment cards. For that reason alone, the Examiner has failed to make out a prima facie case of obviousness and the rejection of claim 1 should be reversed.

3. The Examiner Has Misconstrued the Band Member Card Element of Claim 1, and the Failure to Give Any Patentable Weight To This Element is Error.

The Examiner at page 2 of the final office action holds as follows:

Applicant may note that limitation “Band-member card group representing a band and members of band” is being interpreted as a rule for playing and does not add any [patentable] weight to the apparatus as claimed.

(Final Rejection, p.2)

The Examiner has committed two errors here. First, this element of the claim has been misconstrued. Secondly, this entire element has been stricken from claim 1 as though it does not exist. Both actions by the Examiner are error.

Paragraph (g) of claim 1 recites a deck of “band member” cards with the deck being divided into a series of groups with each group of “band member” cards designating members of a band. This is an element of a game apparatus and not a rule for playing a game. The claim

recites a deck of cards that is divided into a series of groups. Each group designates a plurality of members of a particular band. This element is directed at defining the structure of a certain deck of cards. It has nothing to do with a rule for playing the game. This element says nothing about the object of the game. It says nothing about how players collect the band member cards. It says nothing about how the band member cards figure into the object or aim of the game. Hence, contrary to the Examiner's interpretation of this claimed element, this portion of the claim is not a rule, but an appropriate recitation of a structural component of the claimed game apparatus. This is to be contrasted with a rule which would set forth the conditions upon which such band member cards could be collected or accumulated. Thus, the subject claim element has nothing to do with a rule, but does describe a particular deck of cards, which form a component of the claimed game apparatus.

There is no basis for the Examiner's interpretation of this element of claim 1. There is nothing in the specification that supports the position that this element is a game rule and not a component of the game apparatus. Claim construction is a question of law. The Examiner's interpretation of this element is wrong as a matter of law and on this basis alone the rejection of claim 1 and the other claims of its group should be reversed.

Turning to the second argument here, the Examiner has concluded that based on his claim interpretation that no patentable weight can be given to this element of the claim. This is indeed a glaring error. The final office action is clear, there is no ambiguity. The conclusion to not give patentable weight to this element is based entirely on a claim interpretation and an erroneous claim interpretation at that. Counsel for Applicant is unaware of any authority that supports the proposition that a claim interpretation standing alone is sufficient basis to decline to give patentable weight to express limitations in a claim. The position taken by the Examiner is

tantamount to concluding that the subject claimed element is non-statutory subject matter under Section 101.

4. The Examiner in Utilizing the Printed Matter Doctrine Utilizes the Wrong Legal Standard.

On page 2 of the final office action, the Examiner concludes:

The only difference between applicant's board game and the cited reference resides in meaning and information conveyed by the printed matter and not considered as patentable subject matter.

Apparently, the differences being referred to between Elrod and claim 1 are those articulated after the above conclusion and prior to the discussion of claims 2-4 appearing on page 3. In particular, the Examiner dismisses the limitation of "a network of irregular paths" and a stage being centrally located on the game board. The Examiner finds that these are aesthetic limitations and bear no criticality to the play of the game. (Final Office Action, p. 2) There is no legal basis for declining to attribute patentable weight to an element simply because that element might be deemed as having aesthetic qualities. That notion of patentability has never been endorsed by the Federal Circuit or its predecessor court, the C.C.P.A. Elements of patent claims, even in utility cases, can have aesthetic attributes, but yet form a part of a claimed invention. In addition, the notion that a limitation can be ignored simply because it bears no criticality to the overall disclosed subject matter has no basis in law. Thus, the entire basis for advancing the printed matter doctrine is fatally flawed. Findings based on aesthetic qualities and criticality can never form the basis for imposing the printed matter doctrine to ignore limitations in a claim.

It is not readily apparent if the Examiner employed the printed matter doctrine in addressing any portion of claim 1. There is one sentence in the rejection that states:

For that matter the path being zigzagged or straight and the stage being placed at any location on the board would not change the functionality of the board.

(Final Office Action, p.3)

That holding is conclusionary and cryptic. There is no basis in fact for such a conclusion. The Examiner has not engaged in any analysis. The conclusion is wrong. The design of the network of paths plays an important and strategic role in the claimed game apparatus. It is the network of paths, as claimed in claim 1 for example, that guide the player over the game board and depending on the route and configuration of these paths and how these paths interrelate with other elements of the game apparatus, there is a substantial functional relationship between these paths and the underlying substrate or game board and associated components. The network of paths have a direct relationship on the strategy and the role that chance plays in the game apparatus and how the other components interplay with a player's movement across the game board. There is indeed a functional relationship between the network of paths as claimed in claim 1 and the underlying game board and other claim components of the game apparatus.

(See Decl. Bryan, Evidentiary App., ¶¶ 7-8).

In any event, even if the printed matter doctrine was intended to be employed with respect to claim 1, the Examiner has utilized the wrong standard. In the one sentence analysis printed above, the Examiner argues that whether the path is zigzagged or straight, or whether the stage is placed in any location on the board, will not change the functionality of the board. That is not the test. The test in a printed matter doctrine case is whether there are any new and non-obvious functional relationships between the printed matter and the substrate. It is not at all clear what the Examiner considers printed matter, if anything, in claim 1. But certainly, there is no analysis and fact finding as to the presence or absence of a functional relationship between the

alleged printed matter and the substrate. As in *In re Gulack*, 703 F.2d 1381 (Fed. Cir. 1983), the board supports the paths. The shape and nature of the paths determine the path of movement of the tokens on the game board. That is indeed a functional relationship. In addition, the shape and nature of the paths form an interplay with a game board and other substitute elements of the game apparatus. Again, as in *Gulack*, the winding paths form a unique position on the game board just as the endless sequence of digits formed a unique position with respect to each other on the endless loop device in *Gulack*.

Claim 11

Claim 11 is as follows:

11. A game board and game comprising: a game board having a performing stage and a network of paths including a plurality of paths that lead to the performing stage; a series of tokens for being advanced from a starting point along paths along the network of paths with the object being to advance the tokens to the performing stage; and at least two decks of cards, a first deck of cards and a second deck of cards, and wherein the first deck of cards include “Consequence” cards that are key to increments designated along the respective paths of the network of paths and the second deck of cards being collectible cards that are collected and exchanged by the players during the course of the game; and wherein the second deck of cards are “Band Member” cards and include a plurality of groups of cards with each group of cards representing a band and the members of the band, and wherein the object of the game is to arrive at the performing stage with a certain number of cards representing a band and its members.

Claim 11 includes at least one element not found in Elrod. In particular, claim 11 requires that the second deck of cards be “band member” cards and include a plurality of groups of cards with each group of cards representing a band and the members of the band. The Examiner deals with this element of the claim by concluding and holding:

“Band-member card group representing a band and members of a band” is being interpreted as a rule for playing and does not add any [patentable] weight to the apparatus as claimed.

(Final Office Action, p.2).

The Examiner engages in a claim construction exercise and determines that the element is nothing more than a rule for playing, and then in conclusionary fashion, concludes that no patentable weight should be given to this element of claim 11. The Examiner’s claim construction is wrong. Furthermore, even if the construction was proper, it is improper to summarily conclude that these limitations in claim 11 are worthy of no patentable weight.

It is important to appreciate that the rejection of claim 11 is not based on the printed matter doctrine. As just noted, it is based on an erroneous claim construction and an erroneous principle of law - the notion that the Examiner is permitted without any basis and any analysis to summarily conclude that limitations of the claim can be ignored. Again, the Examiner does not take the position that the differences between Elrod and claim 11 lie in printed matter.¹ There is no basis for the Examiner concluding as a matter of law that the band member card limitation constitutes a rule for playing a game.

The office action is silent as to how the Examiner arrived at determining that the band member card limitation of claim 11 is simply a rule for playing the game. The limitation in question does not impart any rule. The language of the claim itself does not suggest it to be a rule. The specification does not suggest it to be a rule. Indeed, it is not a rule. The band member card limitation describes an element or a component of the game apparatus. An analysis of the subject limitation reveals that what is claimed here is a deck of cards and that the deck of

¹ The Board will note that the Examiner referred to printed matter at page 2 of the office action, but this was in the context of the paragraph that followed where the Examiner talked about the network of irregular paths and the stage being centrally placed as being an aesthetic and non-critical limitation of playing the game. The Examiner never employed the printed matter doctrine with respect to the band member card limitations in claim 11.

cards is “band member” cards. The limitation does not stop there. The deck of band member cards is required to include a plurality of groups of cards with each group of cards being alike. Still further, this element of the claim requires that each of the groups of like-cards of the band member card deck is required to represent a band and the members of the band. These are structural and functional limitations that define an element of the invention claimed in claim 11.

The Examiner is correct that the band member card limitations of claim 11 are not impacted by the printed matter doctrine. That is, the elements of claim 11 and particularly the band member card limitations do not include recitations of printed matter. Indeed, a rejection based on printed matter cannot be advanced in the absence of an analysis and finding with respect to the functional relationships between claimed printed matter and the various substrates involved. Here there was no analysis and certainly no findings with respect to functional relationships.

For the foregoing reasons, the Examiner has not made out a prima facie case of obviousness with respect to claim 11.

B. The 35 U.S.C. §103(a) Rejection Based on Elrod in View of *Ex Parte Breslow/In re Ngai/In re Gulack* As Applied in Claim 1 and in Further View of Hunsberger, U.S. Patent No. 6,279,908.

Claim 6

As with the rejection of claim 1 and the associated group of claims, this rejection is fundamentally flawed because of the inclusion of case law as references. For that reason alone the rejection should be reversed.

Furthermore, the Examiner has not made out a prima facie case of obviousness. The Examiner notes that Hunsberger teaches color coding cards for the purpose of the cards corresponding to certain spaces on the game board. Then the Examiner concludes:

One of ordinary skill I (sic) art at the time the invention was made would have suggested using such commonly used techniques to match a card to a space. (emphasis added)

The Examiner's motivation to combine is flawed. Claim 6 has nothing to do with matching a card to a space on a game board. To the contrary, claim 6 is directed to a means for distinguishing one group of cards of the band member cards from another group of band member cards. Thus, the proffered motivation is not consistent with the claim language, nor consistent with how Elrod would have to be modified to meet the terms of the claim. In addition, the proffered motivation is conclusionary. Simply because there are "commonly used techniques" does not mean that a claimed invention having the so-called commonly used technique would be obvious. The claim must be evaluated and analyzed as a whole. If the Examiner's proffered motivation was legally correct, then it would automatically follow that all "commonly used techniques" would be obvious as a matter of law when recited in any claim. That, of course, cannot be the case. In terms of making out a prima facie case of obviousness the fact that a technique or structure may be common can never alone establish obviousness. Rather, the Examiner must first determine if there is a motivation for modifying the primary reference with the common technique or structure. If there is, then it is incumbent upon the Examiner to proffer a motivation for doing so where the proffered motivation is supported by substantial evidence.

C. The Rejection of Claim 14 As Being Obvious and Unpatentable Over Elrod in View of *Ex Parte Breslow*/*In re Ngai*/*In re Gulack*.

Claim 14

Claim 14 is as follows:

14. The game board and game of claim 11 wherein the network of paths includes an outer path that extends around the game board; at least one intermediate path that extends around a portion of the game board and is disposed inwardly of the outer path; a generally curved path that extends in a curved fashion around at least a portion of the performing stage; and a series of feeder paths that extend from an intermediate path to the generally curved shaped path that curves around at least a portion of the performing stage.

Again, the articulated rejection mixes a prior art patent with three judicial decisions. That is, of course, unusual and confusing. For that reason alone, the rejection of claim 14 should be reversed.

Furthermore, the rejection of claim 14 as articulated on pages 4 and 5 of the final office action is confusing and difficult to understand. The problem is brought about by the Examiner's failure to comply with the basic rules for articulating an obviousness rejection. The Examiner is required in an obviousness rejection to articulate the differences in the claimed invention and the applied reference. See Section 706.02(j) of the MPEP. First, the rejection seems to imply that Elrod shows each of the four separate types of paths required by claim 14. Then the Examiner goes on to state:

The only difference between applicant's board game and the cited reference resides in meaning and information conveyed by the printed matter and not considered as patentable subject matter.

This conclusion is also problematic for several reasons. First, the Examiner is not comparing the invention claimed in claim 14 with the Elrod reference. To the contrary, the Examiner is comparing "applicant's board game" with the "cited reference." Then the Examiner goes on to state that:

The path being a network of irregular paths and stage being centrally located are aesthetic limitations and bear no criticality to playing the game.

The claim at issue, claim 14, does not say anything about the location of the stage or that the stage is centrally placed. That limitation appears in claim 1 - not claim 14. Further, as discussed above with respect to claim 1, the notion that limitations can be characterized as aesthetic and not bearing criticality to unclaimed subject matter is not found in the patent law. These findings and conclusions, however unsupported, cannot as a matter of law defeat patentability. Then the Examiner goes on and states that the path being zigzagged or straight and the stage being placed at any location on the board would not change the functionality of the board. There is no substantial evidence supporting that conclusion. The board has numerous functions and one of those functions is to guide the tokens along various paths or routes along the game board. Certainly, changing the path or route that a player moves during the course of a game effects the functionality of the game board. There is clearly a relationship between the four separate paths set forth in claim 14 and the functionality of the game board. Claim 14 refers to an outer path (116), at least one intermediate path (118) that is disposed inwardly of the outer path, a curved path (140) that extends around at least a portion of the performing stage, and a series of feeder paths (120) that extend from an intermediate path to the generally curved path that curves around a portion of the performing stage. The provision of these paths guide the movement of players over the game board during the course of a game, and as such there is a definite and clear functional relationship between these paths and the underlying substrate, the game board.

In the end, the Examiner was correct in not applying the printed matter doctrine to reject claim 14. In the end, the Examiner concluded:

In order to make the game attractive, it would have been obvious to vary aesthetics of the board by modifying the game board to one of the zigzag, straight and curvilinear without changing the scope and spirit of the game.

One of ordinary skill in the art at the time the invention was made would have suggested modifying configuration of playing path and location of center stage for changing the aesthetics of the game and attracting players.

The proffered motivation for modifying Elrod is fatally flawed. First, the proffered motivation is not even consistent with claim 14. Claim 14 says nothing about the stage assuming a generally central location. The Examiner has confused the limitations of claim 1 with the limitations of claim 11. Moreover, there is no evidentiary support for the position that the claimed paths are aesthetic features of a game board and are routinely changed and altered for aesthetic reasons. With all due respect, the Examiner has put forth this finding without any factual support. It cannot be found in Elrod and it cannot be found in the general knowledge of those skilled in the art. Certainly the Examiner has not referred to any support for that factual finding. Indeed the reality is just the opposite. The reason for the number of paths and how the paths flow across the game board and how they interrelate is intimately tied to the game itself and particularly the strategy of the game and the attributes of the game that make it fun, amusing and challenging to play.

Therefore, the Examiner has failed to make out a prima facie case of obviousness with respect to claim 14.

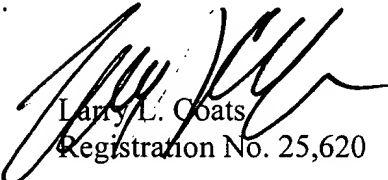
CONCLUSION

For the foregoing reasons, the Board should reverse the Examiner and allow claims 1-11 and 13-15.

Respectfully submitted,

COATS & BENNETT, P.L.L.C.

By:

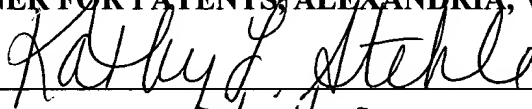

Larry L. Coats
Registration No. 25,620

P.O. Box 5
Raleigh, NC 27602
Telephone: (919) 854-1844

CERTIFICATE OF MAILING

I HEREBY CERTIFY THAT THIS DOCUMENT IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE AS FIRST CLASS MAIL, POSTAGE PREPAID, IN AN ENVELOPE ADDRESSED TO: **MAIL STOP APPEAL BRIEF-PATENTS, COMMISSIONER FOR PATENTS, ALEXANDRIA, VA 22313-1450.**

SIGNATURE _____



DATE _____

3/24/05

(9) CLAIMS APPENDIX

1. A game board and game, comprising:

- (a) a game board having a starting area, a network of irregular paths that lead from the starting area; and a central performing stage located generally centrally on the game board and connected to at least one segment of the network of paths;**
- (b) the network of paths including a series of segments wherein each segment is broken down into increments and wherein at least some of the increments include indicia formed thereon that dictate an action for landing on a particular increment;**
- (c) a series of tokens provided with the game board wherein a token may be assigned to one player and during the course of a game the token is advanced along one or more of the segments of the network of paths;**
- (d) at least one die that is used to determine the number of increments that a player's token can be advanced during the course of the game;**
- (e) a supply of money that during the course of the game is distributed to the players;**
- (f) a deck of "Consequence" cards that are keyed to certain increments on the network of paths, each "Consequence" card having indicia thereon that sets forth a consequence and wherein a player landing on an increment that calls for drawing a consequence card must comply with the directive set forth on the drawn consequence card;**
- (g) a deck of "Band Member" cards with the deck being divided into a series of groups with each group of "Band Member" cards designating members of a band;**
- (h) a series of "Band Equipment" cards with each card designating band equipment; and**

- (i) wherein the object of the game is for each player to advance his or her token along the network of paths and reaches the central stage with a predetermined number of one group of “Band Member” cards and a “Band Equipment” card.
2. The game board and game of claim 1 wherein the game board is provided with a threshold destination at a point along one of the segments that make up the network of paths and wherein a player is entitled to purchase a “Band Equipment” card upon reaching the threshold destination.
3. The game board and game of claim 2 wherein the threshold destination lies on an increment along one of the paths of the network of paths and whereupon a player is permitted to purchase a “Band Equipment” card at one price when he or she lands on the increment having the threshold destination, and to purchase a “Band Equipment” card at a higher price if the player advances past the increment having the threshold destination and does not, in fact, land on the increment having the threshold destination.
4. The game board and game of claim 3 wherein the threshold destination is designated as a pawn shop.
5. The game board and game of claim 1 wherein the tokens comprise a series of miniature buses.
6. The game board and game of claim 1 wherein the group of “Band Member” cards are color coded such that each group may be distinguishable by color.

7. The game board and game of claim 1 wherein the network of paths include a curved shaped path that extends at least partially around the performing stage.
8. The game board and game of claim 7 wherein the network of paths include a series of feeder paths that feed into the curved shaped path that at least partially surrounds the performing stage.
9. The game board and game of claim 8 wherein the network of paths include an outer loop path that extends around the game board.
10. The game board and game of claim 9 wherein the network of paths include a series of intermediate paths that lie inwardly of the outer loop path and wherein the curved shaped path that at least partially surrounds the performing stage lies inwardly of the intermediate paths and wherein the feeder paths extend between one or more intermediate paths and the curved shaped path that at least partially surrounds the performing stage.
11. A game board and game comprising: a game board having a performing stage and a network of paths including a plurality of paths that lead to the performing stage; a series of tokens for being advanced from a starting point along paths along the network of paths with the object being to advance the tokens to the performing stage; and at least two decks of cards, a first deck of cards and a second deck of cards, and wherein the first deck of cards include "Consequence" cards that are key to increments designated along the respective paths of the network of paths and the second deck of cards being collectible cards that are collected and exchanged by the players during the course of the game; and wherein the second deck of cards

are “Band Member” cards and include a plurality of groups of cards with each group of cards representing a band and the members of the band, and wherein the object of the game is to arrive at the performing stage with a certain number of cards representing a band and its members.

12. [cancelled]

13. The game board and game of claim 11 further including a third deck of the “Band Equipment” cards and wherein a further object of the game is to arrive at the performing stage with a “Band Equipment” card.

14. The game board and game of claim 11 wherein the network of paths includes an outer path that extends around the game board; at least one intermediate path that extends around a portion of the game board and is disposed inwardly of the outer path; a generally curved path that extends in a curved fashion around at least a portion of the performing stage; and a series of feeder paths that extend from an intermediate path to the generally curved shaped path that curves around at least a portion of the performing stage.

15. The game board and game of claim 1 including a supply of money that is distributed to the players and wherein during the course of the game the players exchange the money, or collect or pay money according to increments designated on the game board.

(10) EVIDENTIARY APPENDIX

IN THE UNITED STATES PATENT OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of)	
Paul Bryan)	
)	
Serial No.: 09/871,349)	Patent Pending
)	
Filed: May 31, 2001)	Examiner: Vishu Mendiratta
)	
For: Game Board and Game Having a Touring)	Group Art Unit: 3711
Band Theme)	
)	
Attorney's Docket No: 4822-001)	
)	
		Raleigh, North Carolina
		March 24, 2005

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

DECLARATION OF PAUL BRYAN UNDER RULE 1.132

I, Paul Bryan, reside at 413 East Millbrook, Raleigh, NC 27609 and declare as follows:

1. I am the inventor of U.S. Patent Application Serial No. 09/871,349 entitled "Game Board and Game Having a Touring Band Theme."
2. I have reviewed the pending claims in this application, including claims 1-11 and 13-15. I have further reviewed the office action dated November 24, 2004 and the Elrod patent.
3. The Elrod patent shows a game with a band theme and does include two paths, performing stages including a final stage, concert platform, a pair of dice, a series of band member tokens, a plurality of "challenge" cards, and a plurality of "rescue" cards. In the Elrod game, each player selects a concert platform and advances their concert platform from the starting point to the ending point, the final stage, by rolling the dice and following specific instructions. In Elrod, the band member tokens comprise a number of tokens that represent

generic band members, such as a singer, guitarist, drummer, etc. In Elrod's game the band members are sold for money and in the end the player with the most money wins.

4. The "challenge" cards in Elrod permit players to challenge themselves or their opponents to perform some act or task. The "rescue" cards 126 in Elrod permit players to name alternative musical artists as needed when beginning a turn. "Rescue" cards also allow players to fend off challenges and avoid other troublesome situations.

5. Elrod does not include any band member cards. Neither the "challenge" cards nor "rescue" cards of Elrod can be interpreted to be band member cards. More particularly, neither the "challenge" card nor "rescue" cards of Elrod include a series of groups of cards where each group is alike and each group represents a band and its members.

6. In my invention and as set forth in claim 1, as well as claim 13, there is provided band equipment cards. There are no band equipment cards shown or talked about in the Elrod patent.

7. In my invention, the game board is provided with a network of paths that include an outer path and at least one intermediate path that extends around a portion of the game board and which is disposed interiorly or inwardly of the outer path. Further the game board includes a generally curved path that extends in a curved fashion around at least a portion of the performing stage and a series of feeder paths that extend from the intermediate path to the generally curved shaped path that extends around a portion of the performing stage. In the specification and drawings, the outer path is referred to by the numeral 116 while the intermediate path is referred to by the numeral 118, the curved path being referred to by the numeral 140 and the series of feeder paths being referred to by the numeral 120. These paths are functionally related to the game board as they define the path that the individual player tokens move along during the course of the game. These respective paths have an interplay with the consequence cards and the dies. Together, all of these components interrelate and control the path that a player's token moves on the board during the course of a game. These

paths are also functionally related to the strategy of the game and to the consequences and results that flow from the chance element of the game. By changing the paths one will inherently change the game board and the nature and characteristics of the game. There is a functional relationship between the paths and the game board and even other elements of the game apparatus.

8. To the extent that there is a question about the functional relationship of any printed matter to the band member cards for example, there is a functional relationship here. The deck of band member cards includes a series of separate and distinct sets or groups of cards. There must be some means to distinguish one set from another set. Whether this is accomplished through indicia or physical structure, the result is the same. The indicia or physical structure is functionally related to the card because it identifies and distinguishes one of the plurality of groups of cards from another of the plurality of groups of cards. Further, the indicia or physical structure utilized to distinguish and identify one band group from another band group, and in so doing identifies and distinguishes the band members of one group from the band members of another group. The cards support this distinguishing material or structure.

9. I hereby declare under penalty of perjury that to the best of my knowledge and belief all of the foregoing statements are true.

By: Paul Bryan
Paul Bryan

Date: 3-24-05